UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/621,275
Filing Date: July 17, 2003
Appellant(s): DAVIS ET AL.

Mary J. Breiner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 17 September 2007 appealing from the

Office action mailed 28 June 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6853980	Ying	2-2005
6882334	Hayes	4-2005

| 20030119478 | Nagy | 6-2003 |
| 20010042124 | Barron | 11-2001 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 6, 10, and 18-20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ying et al (US Patent #6,853,980, filed 9/7/1999) in further in view of

Hayes et al (US Patent #6,882,344, filed 7/25/2000).

As per independent Claim 1, Ying et al discloses a method comprising:

- A font consumer requesting a font from a font provider (FIG 29, 54; Column

  22, lines 31-42: Discloses a user having the ability to request a font from the

  font store)

- The font provider accessing subscription information from the font customer;

  (Column 10, line 64 - Column 11, line 3: Discloses a record of previous

  purchase and financial information about the customer's account. In addition,

  Column 30, lines 22-30 discloses the purchase of the font covers the

  licensing of the font wherein the license includes the length of time the font

  may be used.)

- The font provider sending the requested font to the font customer depending

  on the subscription information; (FIG 35-37: Discloses the use of payment

  wherein once font provider receives payment, then the font provider provides

  the font customer the font to be downloaded.) the font provider giving lifetime

information with the requested font, the lifetime information defining a

predetermined period of time for which the font consumer is authorized to use

the requested font and defining a predetermined access for use based on the

subscription information. (Column 30, lines 22-30 discloses the purchase of

the font includes a license wherein the license describes the length if time for

the font could be used and authorized use such as limitations of downloads,

copying, number of machines it may be used on, and the number of

characters of a given font can be used; thus disclosing the license includes a

predetermined period of time and access for use)

Ying et al discloses the font consumer receiving the requested font and providing

the requested font to an application by installing the requested font in the font consumer

for the predetermined period of time and for the predetermined access (Claim 6,

Column 32-33: Discloses downloading a font to the client whereby used by the client's

operating system. Column 11, lines 49-56: discloses a font manager installing the font;

Column 30, lines 22-30: discloses the font license how long the font may be installed

and what access rights are allowed for font)

However, Ying et al fails to specifically discloses the required font is tracked so

that upon expiration of said predetermined period of time, the font is disabled. However,

Hayes et al discloses a feature of a font for sale could be sampled for a period of time

and disabled when the font when the time expired. (Column 8, lines 46-48) It would

have been obvious to one of ordinary skill in the art at the time of the Applicant's

invention to have modified Ying et al's method with Hayes et al's feature of disabling the

font after the predetermined time expired in order to provide a font management system

for implementing limited access to fonts after terms of agreement have expired.

As per dependent Claim 2, Ying et al discloses a method further comprising:

- the font consumer accessing a web site of the font provider; (FIG 5,50:

  Browser access the main homepage of font store)

- the font consumer logging onto the web site; and (FIG 32-33; Column 23,

  lines 17-33)

- the font consumer identifying the requested font. (FIG 29: Fonts identified by

  the request are added to the user's shopping cart account whereby the

  customer is able to identify the fonts selected)

As per dependent Claim 3, Ying et al fails to specifically disclose the font provider

is able to accessing a subscriber database; looking up the font consumer in the

subscriber database, and reading font privileges associated with the font consumer.

However, Ying et al discloses an e-commerce server by the font store that includes a

database containing data for each customer that includes an ID, user name, user

password, shopping cat for storing fonts not purchased yet, and account history that

include record of previously purchased fonts and financial information of the customer's

account. (FIG 1; Column 10, line 64 - Column 11, line 3) In addition, Ying et al discloses

the use of licenses on the limitations on the purchase of fonts. (Column 30, lines 22-30)

It would have obvious to one of ordinary skill in the art at the time of applicant's

invention to have used Ying et al's method with the font store to have access user

privilege and financial information since it would have enabled a system to aid in the

distribution, buying, and selling of fonts.

As per dependent Claim 6, Ying et al discloses a method comprising:

- the font provider giving privilege information with the font, the privileges

  information defining approved uses for the requested font by the font

  consumer. (Column 30, lines 22-30: Discloses the use of a license of

  limitations of use on copying, distribution among machines, and number of

  characters used.)

As per dependent Claim 10, Ying et al discloses a method comprising:

- the installing of the font occurs in random access memory of the font

  consumer. (Column 11, lines 50-55: discloses a font manager installing fonts.

  It is inherent, in order for it to be used by applications such as a word

  processing program, for the requested font to be installed into random access

  memory.)

As per independent Claim 18, Ying et al discloses a method comprising:

- a font consumer requesting a font from a font provider (FIG 29) and providing

  payment for the font; (FIG 34-35) based on subscription information defining a

  specified time period of use and a specified use access (Column 30, lines 22-30:

Ying et al clearly discloses "When the sale or purchase of fonts those words are

meant to cover licensing of fonts in return for money as well as their outright

sale." The license describes the length if time for the font could be used and

authorized use such as limitations of downloads, copying, number of machines it

may be used on, and the number of characters of a given font can be used; thus

disclosing the license includes a predetermined period of time and access for

use.)

- the font provider sending the requested font to the font consumer (FIG 37 – the

  store server sends the font once it receives a request for a font download) along

  with a license for the font consumer that enables the font consumer to use the

  font for a specified time period and the specified use access; and (Column 30,

  lines 22-30 – Discloses the license to include the length of time that could be

  used and specified use access of the font)

Ying et al discloses the font consumer receiving the requested font and providing

the requested font to an application (Claim 6, Column 32-33: Discloses downloading a

font to the client whereby used by the client's operating system.) for the specified period

of time at specified use access (Column 30, lines 22-30 – Discloses the license to

include the length of time that could be used and what access right can be used of the

font during that time)

However, Ying et al fails to specifically discloses that upon expiration of said

predetermined period of time, the requested font is disabled. However, Hayes et al

discloses a feature of a font for sale could be sampled for a period of time and disabled when the font when the time expired. (Column 8, lines 46-48) It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have combined Hayes et al's method with Hayes et al's feature of disabling the font after time expired in order to provide a font management system for implementing limited access to fonts after terms of agreement have expired.

As per dependent Claim 19, the applicant recites similar limitations for performing the method of Claim 1. Therefore, Claim 19 is similarly rejected under rationale.

As per dependent Claim 20, the applicant recites similar limitations for performing the method of Claim 2. Therefore, Claim 20 is similarly rejected under rationale.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ying et al (US Patent #6,853,980, filed 9/7/1999) in further in view of Hayes et al (US Patent #6,882,344, filed 7/25/2000) in further in view of Nagy et al (US PGPub 2003/0119478, filed 7/22/2002).

As per dependent Claim 4, Ying et al fails to specifically disclose further comprising debiting an account of the consumer. However, Nagy et al discloses the use of a subscriber entering a debit card number into a website and the subscriber's card account is debited. (Paragraph 0004, lines 7-10)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Ying et al's method with Nagy et al's method since Nagy et al's method would have provided a method and system for prepaying that

enables the use of debit card payments which can be accepted from virtually any

issuing financial institution.

Claims 5, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Ying et al (US Patent #6,853,980, filed 9/7/1999) in further in view of Hayes et al

(US Patent #6,882,344, filed 7/25/2000) in further in view of Barron (US PGPub

2001/0042124, filed 1/26/2001).

As per dependent Claim 5, Ying et al fails to specifically disclose that the font

provider encrypting the font prior to transmission to the font consumer. However, Barron

discloses a method of encrypting electronic data into an encrypted data packet on a

server prior to being retrieved. (Paragraph 0023, line 7 – Paragraph 0024, line 2).

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to have combined Ying et al's method with Barron's method since

Barron's method would have facilitated virtually impregnable security for the delivery,

storage and sharing of documents and files.

As per dependent Claim 21, the applicant recites similar limitations for performing

the method of Claim 5. Therefore, Claim 21 is similarly rejected under Ying et al and

Barron.

Claims 11, 13, and 17 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hayes et al (US Patent #6,882,344, filed 7/25/2000) in further view of

Ying et al (US Patent #6,853,980, filed 9/7/1999).

As per independent Claim 11, Hayes et al discloses system on a computer comprising:

- a font request interceptor receiving demands for fonts from applications running on the computer; (e.g. Column 1, lines 63-65; Column 7, lines 7-18 – A user selects a font from a word processing system wherein the operating system responds to the action, and returns the details of the font for use in the word processing program. Therefore, the operating system act as a interceptor.)

- a font retriever for requesting the demanded fonts from a remote font provider if the demanded fonts are not installed on the computer; (Column 7, lines 25-36)

- a font installer for receiving and installing the demanded fonts; and (Column 7, line 63 – Column 8, line 5; Column 4 lines 32-33 – The update function receives the font onto the font manager wherein the user can activate the font in which the font manager installs the activated font.)

- font tracker for monitoring and controlling use of the demanded fonts by the applications in response to privilege information, defining a predetermined use access, received from the remote font provider. (Column 3, lines 38-45 – Discloses an embodiment of predetermined use access wherein the maximum number of users, e.g. licensees, are able to access the font. Discloses the state of monitoring and controlling the use by disclosing the maximum number of authorized users of using the font is ten, and if the

number of users goes above ten, then the others above ten accessing the

font will be denied. Shows consistency that if the license states only ten

authorized users are only allowed to access the font, then no more than ten

users are able to access the font.)

However, Hayes et al fails to specifically disclose said privilege information

defining a predetermined time period of use, where the font tracker disables the

demanded font after expiration of said predetermined period of time. However, Hayes et

al discloses a feature of a font for sale could be sampled for a period of time and

disabled when the font when the time expired. (Column 8, lines 46-48) It would have

been obvious to one of ordinary skill in the art at the time of the Applicant's invention to

have modified Hayes et al's method with Hayes et al's feature of disabling the font after

the predetermined time expired in order to provide a font management system for

implementing limited access to fonts after terms of agreement have expired.

In addition, Hayes et al fails to specifically disclose the font retriever providing

subscription information to the remote font provider. However, Ying et al discloses when

purchasing a font, information regarding the license is sent containing of the length of

time the font can be used. (FIG 35-37: Discloses the use of payment wherein once font

provider receives payment, then the font provider provides the font customer the font to

be downloaded. Column 30, lines 22-30 discloses the purchase of the font includes a

license wherein the license describes the length if time for the font could be used and

authorized use such as limitations of downloads, copying, number of machines it may

be used on, and the number of characters of a given font can be used; thus disclosing

the license includes a predetermined period of time and access for use.)

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to have modified Hayes et al's method with Ying et al's method's

feature of selling the use of fonts for a period of time and access since Ying et al's

method would have provided a system which aids in buying, selling, and distribution of

fonts.

As per dependent Claim 13, Hayes et al fails to specifically disclose the font

retriever accesses a web site of the font provider and logs onto the web site to bed

identified by the font provider. However, Ying et al discloses accessing a web site of the

font provider; (FIG 5,50: Browser access the main homepage of font store), logging onto

the web site to be identified by the font provider. (FIG 32-33; Column 23, lines 17-33)

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to have modified Hayes et al's method with Ying et al's method of

accessing and logging into a website of a font provider since Ying et al's method would

have provided a system which aids in buying, selling, and distribution of fonts.

As per dependent Claim 17, Hayes et al discloses a method comprising:

installing the font in random access memory of the font consumer. (It is inherent for a

font to be installed into random access memory in order for it to be used by applications

such as a word processing program.)

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over by

Hayes et al (US Patent #6,882,344, filed 7/25/2000) in further view of Ying et al (US

Patent #6,853,980, filed 9/7/1999) in further in view of Barron (US PGPub

2001/0042124, filed 1/26/2001).

As per dependent Claim 14, Hayes et al and Ying et al fails to specifically

disclose that the font retriever decrypts the demanded font. However, Barron discloses

a method of downloading a decryption applet and decrypting the encrypted data packet

at the client workstation. (Paragraph 0024, lines 9-13).

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to have combined Ying et al's method with Barron's method since

Barron's method would have facilitated virtually impregnable security for the delivery,

storage and sharing of documents and files.

(10) Response to Argument

On pages 7-10, Appellant argues that Ying and Hayes do not render independent

claims obvious within the meaning of 35 USC 103. Appellant argues Ying does not

teach a method or system for distributing or managing fonts by rental involving the

combination of features as claimed by appellants and that Ying provides no description

as to how to provide or implement or enforce a license or sale including limitations. In

addition, Appellant argues Hayes describes a system and method for examining font

files for corruption, a method or system for renting a desired front for a predetermined

period of time and access is not described; therefore, submitting that the modification

necessary to the teaching of Hayes to obtain the claimed methods or systems is beyond the teaching or suggestion of Ying or Hayes. As a result, Appellant states the claimed methods and systems have a different purpose and are defined by specific features to achieve that purpose that are not taught or suggested by Ying or Hayes. However, the Examiner disagrees.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., to provide or implement or enforce a license or sale including limitations) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Based on the arguments, in reference to Ying, the Examiner is unsure which features and limitations the Appellant stated in the arguments is focusing on (e.g. Page 9, second paragraph) since the Appellant is arguing the claims as a whole in respect to Ying. Therefore, the Examiner is viewing the argument as in Ying does not teach the limitations of Claim 1.

Ying provides a method for distribution or managing fonts by rental based on the limitations on Claim 1.

- Ying discloses a font consumer requesting a font from a font provider, disclosed in FIG 29, 54; Column 22, lines 31-42, wherein Ying discloses the user has the ability to request a font to purchase or download in which the user selected from the font store.

- Ying discloses the font provider accessing subscription information from the font customer, discloses in Column 10, line 64 - Column 11, line 3, wherein Ying discloses information of a record of previous purchase and financial information about the customer's account is stored for access. In addition, Ying further discloses that customer account involves the purchase of the font covers the licensing of the font wherein the license includes the length of time the font may be used as disclosed in Column 30, lines 22-30.

- Ying discloses the limitation the font provider sending the requested font to the font customer depending on the subscription information, disclosed in FIG 35-37, wherein the figures discloses processing of a payment wherein once font provider receives payment, then the font provider provides the font customer the font to be downloaded.

- Ying discloses the font provider giving lifetime information with the requested font, the lifetime information defining a predetermined period of time for which the font consumer is authorized to use the requested font and defining a predetermined access for use based on the subscription information as in

Column 30, lines 22-30, wherein Ying discloses the purchase of the font

includes a license wherein the license describes the length of time for the font

could be used and authorized use such as limitations of downloads, copying,

number of machines it may be used on, and the number of characters of a

given font can be used; thus disclosing the license includes a predetermined

period of time and access for use.

- Ying et al discloses the font consumer receiving the requested font and

  providing the requested font to an application by installing the requested font

  in the font consumer for the predetermined period of time and for the

  predetermined access as disclosed in Claim 6, Column 32-33, wherein Ying

  discloses downloading a font to the client whereby used by the client's

  operating system wherein the client has a font manager in which the font

  manager installs the font (disclosed in Column 11, lines 49-56. Furthermore,

  Ying discloses the font license how long the font may be installed and what

  access rights are allowed for font, as disclosed in Column 30, lines 22-30.

However, Ying et al discloses that a license that involves the length of time and

use of access, but fails to specifically discloses the required font is tracked so that upon

expiration of said predetermined period of time, the font is disabled. However, Hayes et

al discloses a feature disabling a font after time expires of a font a user had the ability to

use the font for a short period of time until further action is decided and done by the

user. (Column 8, lines 46-50) It would have been obvious to one of ordinary skill in the

art at the time of the Applicant's invention to have modified Ying et al's method with

Hayes et al's feature of disabling the font after the predetermined time expired in order

to provide a font management system for implementing limited access to fonts after

terms of agreement have expired. The Examiner is not combining whole inventions by

brute force when the Examiner stated the obvious statement in the Office Action. The

Examiner is modifying Ying's invention of distributing fonts to include the feature that is

disclosed in Hayes, not the entire invention, based on what is stated in the language of

the claim language. While Hayes discloses the ability to examine font files for corruption

in other aspects of the invention wherein Hayes, Hayes also discloses the feature to

distribute and manage fonts by having font be used by users for a short time, then

disabled when time expires. Thus, Ying and Hayes disclose a common endeavor in the

same field of art since Ying and Hayes discloses distributing and managing fonts. In

conjunction with Ying, Ying and Hayes provide a license that defines the length of time

usable and access rights, wherein the length of time expires, the font would be disabled

until further action is decided by the user which provides a font management system

aiding in buying, selling, and distribution of fonts and for implementing limited access to

fonts after terms of agreement have expired.

All other arguments on pages 12-14 are referring to the dependent claims and

parallel claims are in reference to the topics above, thus the rationale above can be

used to respond to the similar arguments.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

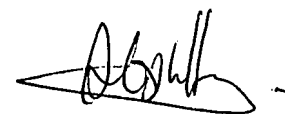Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

David Faber

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

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